

REMARKS:

Claims 1-12 are in the case and presented for consideration.

Claims 1-7 were rejected under 35 U.S.C §103(a) as being obvious from Japanese patent JP11-238262 to Otani et al. in view of Japanese patent JP2000-40263 to Inaba and U.S. Patent 5,791,990 to Schroeder et al.

First, proposed claim 6 recites "at least one defined area with a border and central portion situated in the annular or recording portion above the basic cover paint and containing a hidden printing." The Office construes the color adhesives of Otani as basic cover paint recited in the claims. The Office also construes the drawing or picture ABCDE, formed by the color adhesives, as the printing recited in the claims. Since the printing ABCDE is undisputably formed by the color adhesives, the colored adhesives are at the same level as the printing ABCDE. Therefore, claim 7 fails to teach or suggest at least one defined area situated above the basic cover paint and containing a hidden printing.

Second, claim 1 recites a compact disc comprising a recording portion, a recording and reflective layer on the recording portion, a defined area...in the annular or recording portion," and "a scratch-off paint coating covering said defined area." Although the Office may not have given any patentable weight to the phrase compact disc, it must give patentable weight to the remainder of the elements which are recited in the body of the claim. The Office states that "Schroeder et al. shows a scratch-off paint coating to be used for compact discs (column 3, lines 24-25)." Applicants respectfully submit that the Office's position is incorrect based on the arguments provided in applicant's previous response of April 8, 2005 (see middle of page 8 continuing to middle of page 10). Those arguments

are incorporated herein and will be addressed in the interview. In particular, Schroeder only discusses magnetic media. At column 3, lines 24-25, Schroeder '990 states:

a package containing a magnetic medium (e.g. a floppy or compact disc) and a ticket or card.

The notation *e.g.* is an abbreviation for the phrase *for example*. Therefore, a compact disc is an example of a magnetic medium according to Schroeder '990.

At column 5, lines 37-38, the patent further states that:

"magnetic media contemplated by the present invention includes so-called 'floppy' and 'compact' discs."

Only the word *compact* is in quotation marks, while the word *discs* is not in quotation marks. Thus, Schroeder only teaches compact or small magnetic discs. Magnetic medium does not contain a recording portion and a recording and reflective layer on the recording portion. Therefore, Schroeder '990 never teaches or suggests a disc comprising a recording portion, a recording and reflective layer on the recording portion, a defined area...in the annular or recording portion," and "a scratch-off paint coating covering said defined area."

Since only magnetic medium is contemplated by Schroeder '990, scratch-off paint could logically only be applied outside the recording surface. There is no teaching or suggestion that scratch-off paint can be placed on the recording surface of the magnetic medium.

Furthermore, Schroeder is not combinable with the other cited references which are related to optical media as opposed to magnetic media, as explained in applicant's previous response.

Third, proposed claim 8 recites "an optically readable disc body having a central annular portion and a recording portion," "at least one defined area...in the annular or recording portion," and a "scratch-off paint coating covering said defined area." None of the cited references teach or suggest

As explained above, Schroeder '990 only discloses magnetic medium. Schroeder '990 does not teach or suggest optical media. Optical discs have nothing in common with magnetic discs. An optical CD is an optically readable medium with pits or differently reflecting spots on its surface arranged along tracks/grooves readable by a laser beam. Since optical discs are very different from magnetic medium, there is no suggestion or motivation to combine the magnetic media of Schroeder '990 with the optical discs of Otani and Inaba. Thus, the cited references are not combinable.

Fourth, Inaba does not teach or suggest "a protective coating," as recited in claim 1. Inaba discloses a protective coating 3 as a leveling or smoothing film which is disposed between the rough surface formed by grooves or pits 1a and the mirror finish surface reflection film 5. Film 3 has no protective effect. Rather, film 3 represents a leveling layer to enable easy printing not affected by the surface unevenness cause by record pits when the reflective layer is not thick enough to provide a smooth surface. Since the object is not to provide a reflective layer with a protective coating, and since the rejection is based on

obviousness, there is no suggestion to combine Inaba with Otani to provide a reflective layer covered by a protective coating. There must be some suggestion in at least one of the references to provide a protective coating for a reflective layer. No suggestion is provided.

Fifth, claim 2 additionally recites at least one limitation not disclosed or suggested in any of the prior art references. None of the cited references teach or suggest "a translucent interlayer coating for protecting the hidden printing when applying and removing the scratch-off paint."

In the rejection of claims 2, 8, and 9, the Office states:

"Inaba shows that the defined area printing is separated from the scratch-off paint by a translucent interlayer 41 for protecting the hidden printing when applying and removing the scratch-off paint."

Initially, applicant notes that Inaba does not disclose a translucent layer 41, as suggested by the Office. In fact, Inaba does not disclose any element with a reference number 41. Although Otani discloses an adhesive sheet 41-1, this sheet is printed with color. This sheet does not protect any hidden printing. The adhesive sheet 41-1 is not a "translucent interlayer for protecting the hidden printing when applying and removing scratch-off paint." Although applicants pointed this out in the previous response, the examiner never made any correction or clarification in the new Office Action.

In the discussion of rejected claim 1 in view of Inaba on page 2 of the present Office Action, there is no mention of a scratch-off paint or printed area, which would both be pertinent to the analysis of claim 1. The Office only mentions scratch-off paint in conjunction with Schroeder '990 and a printed area in conjunction with Otani.

Although Inaba discloses a printing layer 4 formed on the mirror finished surface

reflection film 5, there is only a glue line 6 and a substrate 1B on top of the printing layer 4 shown in Fig. 2. In the remainder of the drawings, there is nothing on top of printing layer 4. There is no scratch-off coating on top of the printing layer 4. Inaba does not discuss scratch-off paint at all. Thus, the printing is not hidden. There is no translucent interlayer coating on top of the printing layer 4 either. Substrate 1B is not an interlayer. Glue is not a coating for protecting the hidden printing when applying and removing the scratch-off paint.

Sixth, none of the cited references teach or suggest an interlayer coating for protecting hidden printing that overlaps the border portion of the defined area by at least 2mm, as recited in claim 3. In fact, none of the references discuss any kind of overlap. The Office's rejection of claim 3 does not state any rationale based on a cited reference. Claim 3 depends from claim 2, and therefore is also patentable for the same reasons as claims 1 and 2.

Seventh, none of the cited references teach or suggest a compact disc "wherein the thickness of the interlayer coating is in the range from 40 to 58 microns," as recited in claim 4. The Office construes the adhesive sheet 41-1 of Otani, having a thickness of 40-50 micrometers, as the claimed interlayer coating. The adhesive sheet 41-1 is a layer having a colored printed material on it. Adhesive sheet 41-1 is not a translucent layer for protecting hidden printing. Claim 4 depends from claim 3, and is therefore also patentable for the same reasons as claims 1-3.

Eighth, none of the cited references teach or suggest a compact disc wherein the scratch-off paint coating bears a guidance printing. Claim 5 depends from claim 1 and is also patentable for the same reasons as claim 1.

Ninth, independent claim 6 recites substantially the same elements and limitations as claim 1. Like claim 1, claim 6 recites a compact disc having "at least one defined area with a border and central portion situated in the annular or recording portion containing a hidden printing," which is not taught or suggested by any of the references. Independent claim 6 further recites a compact disc having "a scratch-off paint coating applied to said interlayer coating." None of the cited references teach or suggest a compact disc having a scratch-off paint coating applied to a translucent interlayer coating. Schroeder '990 only discloses a scratch-off coating for a ticket. Claim 6 is distinguishable from Schroeder '990 for the same reasons that claim 1 is distinguishable from Schroeder '990.

Tenth, claim 7 depends from claim 6 and is patentable for the same reasons as claim 6. Additionally, as explained above for the claim 3 rejection, none of the cited references teach or suggest a compact disc having a translucent interlayer coating that overlaps the border portion of the defined area of the compact disc by at least 2mm. Also, none of the cited references teach or suggest a compact disc having a scratch-off paint coating applied to a translucent interlayer coating that is in the range of 40 to 58 microns in thickness.

Applicant previously added claims 8-12. Independent claim 8 recites "a means for

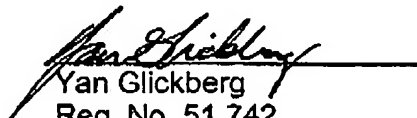
protecting the hidden printing when applying and removing the scratch-off paint." None of the cited references teach or suggest a means for protecting the hidden printing when applying and removing the scratch-off paint. As explained above, Inaba only discloses a leveling or smoothing protective film which is beneath the printed layer. Inaba does not disclose a means for protecting the hidden printing when applying and removing the scratch-off paint. Otani discloses a transparent disk that covers an adhesive sheet 41-1 with visible colored printing, but does not disclose a means for protecting any hidden printing.

Claim 8 is also distinguishable from the cited references based on the arguments made above.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

Respectfully submitted,


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